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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,119	03/14/2001	Daisuke Yano	010324	6260
23850	7590	06/22/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP			UHLIR, NIKOLAS J	
1725 K STREET, NW				
SUITE 1000			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20006			1773	

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/787,119

Applicant(s)

YANO ET AL.

Examiner

Nikolas J. Uhlir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Examiners Note***

1. The examiner notes that in the previous office action a restriction requirement was made. However, this requirement was made using the U.S. standard of restriction. The instant application however, is a national stage entry of an international application. Thus, U.S. restriction practices do not apply to this case. Accordingly, the previous restriction requirement is withdrawn. However, restriction is still proper under PCT standards as is set forth below.

### ***Election/Restrictions***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5 and 12-16, drawn to a transferable magnetic tape and a magnetic card.

Group II, claim(s) 6-11 and 17-19, drawn to a method for manufacturing a transferable magnetic tape.

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

4. The special technical feature of claim 1 is a transferable magnetic tape having a backing layer, printed layer, magnetic recording layer, and adhesive layer formed in this order, wherein the printed layer has uniform thickness and comprises a pattern printed

region and a filling layer region outside the pattern printed region, and the coercivity of the magnetic powder in the magnetic recording layer is in the range of 20-320 kA/m (251-4021Oe).

5. US Patent #5972438 to Suzuki et al. discloses a magnetic tape comprising a holding material 90 (equivalent to applicants claimed backing material), a peeling layer 91, a protective layer 93, a 2nd magnetic layer 95, a first magnetic layer 96, and an adhesive layer 98 (equivalent to applicants claimed adhesive) formed in this order (see figure 19, and column 12, lines 49-column 13, line 10). Suzuki discloses that the second magnetic layer can comprise non-eraseable and non-alterable coding information, such as a bar code pattern or letters (column 2, lines 60-66). As a bar code pattern or pattern of letters includes a pattern printed region and a filling layer region outside the printed region, the 2nd magnetic layer 95 of Suzuki is meet this requirement. In specific embodiments, the thickness of the 2nd magnetic layer is disclosed to be 6 $\mu$ m (column 27, lines 20-30). From this disclosure and from the diagrams, it is apparent that the coating thickness of the second magnetic layer is uniform. Thus, the second magnetic layer of Suzuki meets all of the limitations of the applicant's claimed pattern printed layer. The 1st magnetic layer 96 is comprised of magnetic particles and a binder (column 12, lines 15-25). Suitable magnetic particles include gamma iron oxide (coercivity of 250-400Oe), Cobalt clad gamma iron oxide (coercivity of 600-700Oe), and barium ferrite (coercivity of 1600-1900Oe or 2500-3000Oe) (column 12, lines 3-8). As applicants claimed coercivity range of 20-320 kA/m is equivalent to 251-4021Oe, it is clear that the magnetic particles of Suzuki meet the claimed coercivity range.

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6. As is clearly shown above, Suzuki anticipates all of the limitations encompassing the special technical feature of the invention. Thus, the special technical feature lacks novelty or inventive step, and does not make a contribution over the prior art.

7. A telephone call was made to Donald Hanson on 06/09/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nju

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700